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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087581,992	01/02796	PELLEGRINO	F

LM21/0123

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EXAMINER	
KAZIMI,H	
ART UNIT	**PAPER NUMBER**
2763	

DATE MAILED: 01/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/581,992	Frank.Pellegrino, Robert.Fletcher
Examiner	**Group Art Unit**
Hani Kazimi	2763

☒ Responsive to communication(s) filed on *Jan 2, 1996*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-18* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-18* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. This application has been reviewed. Original claims 1-18 are pending. The objections and rejections cited are as stated below:

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claims are directed towards an abstract idea. Claims 1-18 represent an abstract idea that does not provide a practical application in the technological arts. There is no manipulation of data nor is there any transformation of data from one state to another being performed in "Method for determining the risk associated with licensing or enforcing intellectual property". Actually, there is no post-computer process activity found. "Method for determining the risk associated with licensing or enforcing intellectual property" is not a physical transformation. Thus, no physical transformation is performed, and no practical application is found. Also the claims do not appear to correspond to a specific machine or manufacture disclosed with in the specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al. in view of Robinson W.J. "Insurance coverage of intellectual property lawsuits in the computer industry".

DeTore et al. discloses a method comprising a process interacting with a computer, entering data from one or more sources into said computer, said computer having been pre-programmed such that said data is organized by one or more predetermined risk factors, and evaluating the data by comparing it to a present standard, (see column 4 lines 4-8, lines 24-35, and column 2 lines 31-37). computing a score which represents a relative degree of strength associated with any undertaking to detect risk (see column 5 lines 57 thru column 6 lines 1-2). Even though the method of DeTore et al. is disclosed to interact with a computer, entering data from one or more sources into said computer, said computer having been pre-programmed such that said data is organized by one or more predetermined risk factors, evaluating the data by comparing it to a present standard, and computing a score which represents a relative degree of strength associated with any undertaking to detect risk, it does not particularly teach the claimed

step of commercializing said intellectual property as specified in claim 1, and determining a probable success factor for undertaking the lawsuit involving intellectual property as specified in claim 11, 12 and, 13.

However Robinson teaches the claimed step for commercializing said intellectual property as specified in claim 1, and determining a probable success factor for undertaking the lawsuit involving intellectual property as specified in claim 11, 12, and 13 (see abstract lines 1-9).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to recognize that such well known method for determining a probable success factor for undertaking the lawsuit involving intellectual property as taught in Robinson would have been obviously provided in DeTore et al. so that the method for evaluating a potentially insurable risk can be implemented with the same type of coverage of intellectual property lawsuites in the computer industry as shown in Robinson.

Considering claims 2, DeTore et al. teaches the process of entering the data into the computer via telephone from a location other than the location having the computer (see column 4 lines 1-4)

Considering claim 3 DeTore et al. teaches the predetermined risk factors for organizing the data are selected from the categories of subjects cosisting of : Technical orientation, technical review, preliminary assessment, patent study, market identification and analysis, industry intelligence, cost/benefit analysis, marketing/licensing assessment, and licensing/enforcement.(see column 1 line 59 thru column 2 lines 1-5).

Considering claims 4-7, 14-18 DeTore et al. teaches the claimed computing said score is achieved by calculating a category score, the score is a category score resulting from categorizing various

risk factors into categories and determining a category score (see column 1 line 66 thru column 2 lines 1-15), the category score is weighted and combined with other category scores and used to modify a primary risk indicia to calculate a probable success factor (see column 15 lines 60-65), the composite score is modified by a moral hazard factor to calculate a probable success factor, and the probable success factor is multiplied by projected recoveries to determine the net recovery from commercializing the intellectual property (see column 15 line 65 thru column 16 lines 1-12). Considering claims 8-10, Robinson teaches the claimed intellectual property to be commercialized is a patent, a trademark, and a copyright (see abstract lines 4-6).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Minturn et al. US Patent 5,692,501 Dec. 2, 1997. Scientific wellnes personal/clinical/laboratory assessements, profile and heaith risk managment system with insurability rankings on cross correlated 10-point optical health/fitness/wellness scales.

b) Apgar, IV US Patent 5,680,305 Oct. 21, 1997. System and method for evaluating real estate.

c) Lerner US Patent 5,526,257 Jun. 11, 1996. Product evaluation system.

d) Force et al. US Patent 5,533,123 Jul. 2, 1996. Programmable distributed personal security.

e) DeTore et al. US Patent 4,975,840 Dec. 4, 1990. Method and apparatus for evaluating a potentialy insurable risk.

f) Robinson, W.J. "Insurance coverage of intellectual property lawsuits in the computer industry". International computer law adviser. Vol.6, no. 3-4, p. 21-42.

g) Sullivan, Deidre "American Banker" Jun. 7, 1994 vol.159, p17(1).

14. Any inquiry concerning this statement or earlier statements from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached on Monday - Friday from 8:30 to 5:00.

15. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3800.

Hani.Kazimi.

January/7/1998

KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER